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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,670	01/09/2002	Charles F. Benninghoff III	BEN2.PAU.01	6171
7590                    09/19/2007 CHARLES F. BENNINGHOFF III 26191 Palmetto Place Mission Viejo, CA 92692			EXAMINER	
			TANG, KAREN C	
ART UNIT		PAPER NUMBER		
2151				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/042,670	BENNINGHOFF, CHARLES F.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Karen C. Tang	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 August 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 23-54 is/are pending in the application.
  - 4a) Of the above claim(s) 45-54 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 23-44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

### **DETAILED ACTION**

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/07 has been entered.
- Claims 23-54 are presented for further examination.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 23-54 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Election/Restrictions***

Newly submitted claims 45-54 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly entered claims are directed to posting information to a transaction logs of the certifying authority which divert the claim focus on verifying sender/recipient identities.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification does not provide information on limitations of Claim 23 (i.e., “the encrypted hash value generated by the certifying authority after logging the recipient on to the certifying authority” and “after logging the recipient on to the certifying authority, generating by the certifying authority an encrypted hash value..thereof”).

For examine purposes, these limitation will not be considered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 23, it is unclear whether the term “certifying authority” on lines 4 is the same as “certifying authority” on lines 2. For examine purposes, the “certifying authority” on line 4 and line 2 will be viewed as the same term. “certifying authority” on lines 4, is changed to “the certifying authority”.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25-31, 16, 38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,297,891) in view of Smith et al hereinafter Smith (US 6,385,655).

- 1) Referring to Claim 23, Kara disclosed a method for verifiably transmitting an electronic package from a sender to a recipient through a certifying authority via a public communication network, the method comprising the steps of:  
logging the sender on to a certifying authority using a standard authentication protocol (it is obvious to have sender logon to certifying authority in order to send/check information, i.e., emails message, Col 4, Lines 54-60); creating by the certifying authority an electronic package (indicia of certification, refer to Col 5, Lines 35-43) from inputs (cipher, refer to Col 5, Lines 32-33) transmitted by the sender via the public communications network (sender send it, refer to Col 5, Lines 15-20, a PSN, Fig 1, a public communication network); storing by the certifying authority the inputs relating to the electronic package on a server (the certified program is within PC 30, and PC 30 is a server) operated by the certifying authority for use in later verifying the inputs relating to the electronic package and storing any other data received from the sender (the certified system received the document, is a form of storing, Col 8, Lines 5 and also received a copy of a the indicia, refer to Col 11, Lines 1-5 and Col 14, Lines 37); delivering a message

relative to the electronic package from the certifying authority to the recipient via the public communications network (refer to Col 9, Lines 55-57); logging the recipient on the certifying authority as a response to the receipt of the message (it is obvious to have sender logon to certifying authority in order to send/check information, i.e., emails message, Col 4, Lines 54-60); generating by the certifying authority an encrypted hash value based on the inputs relating to the electronic package and the delivery thereof, the encrypted hash value uniquely identifying the particulars relating to the electronic package and the delivery thereof (MK, refer to Col 7, Lines 7-15); and transmitting an electronic certificate of service from the certifying authority via the public communications network, the electronic certificate of service including selected inputs relating to the electronic package and a digital certificate (refer to Col 10, Lines 27-31).

Although Kara disclosed the invention substantially as claimed, Kara is obvious on disclosing, “logging in the senders and logging in the recipient”.

Smith, in an analogous art, discloses, “logging in the senders and logging in the recipient” (refer to Col 6, Lines 40-55).

Hence, providing features disclosed by Smith, would be desirable for a user to implement methods that tracks the sending and receiving of a document and ways to preserves the format of a delivered document in order to provide least expense ways to reduce mis-formatted document and insure the security of the document.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Kara by including the features provided by Kara.

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- 2) Referring to Claim 25, Kara disclosed the certifying authority embeds the digital certificate on the face of the electronic certificate of service (embedded checksum and the document, refer to Col 10, Lines 28-35).
- 3) Referring to Claim 26, Kara disclosed wherein the certifying authority embeds the digital certificate in the electronic certificate of service electronically (embedded checksum and the document, refer to Col 10, Lines 28-35).
- 4) Referring to Claim 27, Kara disclosed wherein a recipient, sender or other person requests the certifying authority to employ the digital certificate embedded within the electronic certificate of service so as to verify that the contents of the electronic package stored on the certifying authority's server are identical to the description thereof found on the face of the electronic certificate of service (refer to Col 11, Lines 35-67, and Col 12, Lines 1-10).
- 5) Referring to Claim 28, Kara disclosed wherein the certifying authority utilizes the embedded digital certificate within the electronic certificate of service to locate and identify the electronic package (the indicia, refer to Col 11, Lines 1-5).
- 6) Referring to Claim 29, Kara disclosed wherein the certifying authority, having located and identified the electronic package, reproduce the electronic package identically to the first assembled by the certifying authority (the indicia is to find the copy of the document, Col 11, Lines 1-5 and Col 12, Lines 5-10).

- 7) Referring to Claim 30, Kara wherein the reproduced electronic package is certified to be a true and correct copy of the original electronic package, such certification being made by the certifying authority (Col 12, Lines 1-10, Col 12, Lines 34-45).
- 8) Referring to Claim 31, Kara wherein the certifying authority issues a certification to a requesting party that the reproduced electronic package is a true and correct copy of the original electronic package and said certification and electronic package are delivered to said requesting party (refer to Col 10, Lines 34-38, and Col 10, Lines 46-55, and Col 10, Lines 60-65).
- 9) Referring to Claim 36, Kara disclosed wherein comprising the steps of creating the electronic certificate of service as an encrypted file (refer to Col 4, Lines 59-67).
- 10) Referring to Claim 43, Kara disclosed wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service to a designee of the sender other than the recipient (send the confirmation that indicate the message is successful, refer to Col 8, Lines 20-35).
- 11) Referring to Claim 41, Kara disclosed wherein particulars of the inputs of the recipient that are converted to an electronic package by the certifying authority are encrypted using an encrypted key maintained solely by the certifying authority for the purpose of embedding the

same into the electronic certificate of service (certification program generates MK, refer to Col 7, Lines 15-20).

12) Referring to Claim 42, Kara disclosed wherein the step of transmitting an electronic certificate of service transmits an electronic certificate of service to the recipient (refer to Col 10, Lines 50-67).

13) Referring to Claim 38, Kara disclosed verifying an encrypted hash value that is questioned by transmitting the encrypted hash value to the certifying authority; and comparing the encrypted hash value that is questioned with records of the certifying authority (refer to comparing the checksum and Col 11, Lines 45-67).

Claims 24, 32-35, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6, 297,891) in view of Smith et al hereinafter Smith (US 6,385,655) in further view of Cook (US 6,732,101).

14) Referring to Claims 24 and 35, Kara disclosed storing the electronic package inputs and the other related data on the server operated by the certifying authority for use in later producing a duplicate of the electronic package for a period of time agreed upon by the certifying authority and the sender (in order to sent the trusted document, the agreement must been reached prior from sending, the act of sending, is the agreement); and storing the inputs comprising: the name and address of the email sender (identification of sending site), the name and address of the

recipient, the name and email of the address of any other person to whom the certification of service has been delivered, the time of delivery, the date of delivery (refer to Col 14, Lines 30-51)

Although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding

the input comprised the subject of the message, the size of message, the electronic package retention expiration date, the name of each attachment, and the size of each attachment.

Cook, in an analogous art disclosed the subject of the message (the subject of the message (Fig \_4b, Subject), the size of message (it is obvious to provide such feature, that ordinary skill in the art before the date of instant application already invented this feature, therefore, has no patentable weight), the electronic package retention expiration date (time til delete, refer to Fig 4b), the name of each attachment (attachements. 4b), and the size of each attachment (it is obvious to provide such feature, that ordinary skill in the art before the date of instant application already invented this feature, therefore, has no patentable weight),

Hence, providing the subject of the message, the size of message, the electronic package retention expiration date, the name of each attachment, and the size of each attachment. disclosed by Cook, would be desired for user to implement in Kara's system because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Kara and Smith by including the features which provides all

information that certified system would need to know in order to operate accordingly to the information received.

15) Referring to Claims 32, 33 and 34, although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding wherein the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient.

Cook, in an analogous art disclosed the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient (refer to Fig 4c, Number of days to hold the message).

Hence, providing the particulars surrounding the electronic package comprises maximum number of days within which to deliver the electronic package to the recipient disclosed by Cook, would be desired for user to implement in Kara and Smith's systems because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the system of Kara and Smith by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

16) Referring to Claim 37, Kara disclosed wherein the step of creating the electronic certificate of service as an encrypted file (refer to Col 4, Lines 59-67), however, is accomplished by creating an encrypted PDF file that is printable but not modifiable.

17) Referring to Claim 39, although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority.

Cook, in an analogous art disclosed notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority (refer to Col 17, Lines 25-55).

Hence, providing notifying the recipient via the public communications network that the electronic package is available for pickup from the server operated by the certifying authority would be desired for user to implement in Kara and Smith's systems because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the systems of Kara and Smith by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

18) Referring to Claim 40, Kara disclosed wherein the step of delivering the electronic package from the certifying authority to the recipient via the public communications network (refer to Fig 1, 30 is communicate with 20 via PSN).

Although Kara and Smith disclosed the invention substantially as claimed, Kara and Smith are silent regarding the event occurs upon a request for download thereof by the recipient; and

wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step.

Cook, in an analogous art disclosed the event occurs upon a request for download thereof by the recipient; and wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step (refer to Col 17, Lines 15-67).

Hence, providing occurs upon a request for download thereof by the recipient; and wherein the step of transmitting an electronic certificate of service from the certifying authority via the public communications network takes place after completion of the delivering step, would be desired for user to implement in Kara and Smith's systems because it provides easier level to provide appropriate encryption engine for each different recipient that has different decryption engine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have modified the systems of Kara and Smith, by including the features which provides all information that certified system would need to know in order to operate accordingly to the information received.

### *Conclusion*

**Examiner's Notes:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references

in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571)272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*V. marti Wallace*  
SPE AU 2151

Karen Tang